

REMARKS

Upon entry of the present amendment, claims 1-20 are be pending in the application.

Claims 1, 3, 5, 8, and 15-20 have been amended.

No claims have been added or canceled.

No new matter has been introduced by the foregoing amendments.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection under 35 U.S.C. §112.**

Claim 1 has been amended to correct a typographical error, whereby “polyisocyanates” and “polyisocyante” have been amended respectively to “polyisocyanates” and “polyisocyanate”.

Claim 3 has been amended to correct a typographical error, whereby “chlorinanted” has been amended to “chlorinated”.

Claim 5 has been amended to correct a typographical error, whereby “pololefin” has been amended to “polyolefin”.

Claim 8 has been amended to correct a typographical error, whereby “isocyante” has been amended to “isocyanate”.

Claims 15 and 16 have been amended to properly depend from claim 12.

Claim 17 has been amended to delete “is” which was written twice.

Claim 18 has been amended to properly depend from claim 13.

Claims 19 and 20 have been amended to correct a typographical error, whereby “um” has been amended to “µm”.

No new matter has been introduced by the above amendments.

In view of the foregoing amendments, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §112.

2. **Rejection of claims 1-18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Publication No. 2003/0105230 to Hellmann et al., hereafter "Hellmann".**

Hellmann teaches a modular system for the production of coating compositions for coating plastics comprising the following component modules: A) at least one base module containing at least one binder, extenders and/or pigments, optionally together with conventional coating additives, water and/or organic solvents, B) at least one adhesion module containing at least one adhesion-promoting component optionally together with binders, conventional coating additives, extenders, organic solvents and/or water, C) at least one elasticity module containing at least one elasticising component optionally together with conventional coating additives, extenders, organic solvents and/or water and D) at least one binder module containing at least one binder optionally together with additives, organic solvents and/or water. (Hellmann, abstract).

Independent claim 1 is directed to A multicomponent system comprising at least three components, comprising (I) a component which is free from chlorinated polyolefins and is curable with polyisocyanates, comprising (I.1) at least one binder containing isocyanate-reactive functional groups, and (I.2) at least one organic solvent, (II) a component free from binders (I.1), comprising (II.1) at least one chlorinated polyolefin, and (II.2) at least one organic solvent, (III) a component comprising at least one polyisocyanate (III.1).

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Furthermore, "[i]n order to anticipate, a piece of prior art must

clearly and unequivocally disclose the claimed composition or direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference". *In re Arkley*, 59 CCPA 804, 455 F.2d 586, *Air Products & Chemicals, Inc. v. Chas. S. Tanner Co.* 219 USPQ 223, *Perricone v. Medicis Pharmaceutical Corp.* 267 F.Supp.2d 229.

Applicants respectfully assert that Hellmann does not teach all the elements of independent claim 1. Indeed, Hellmann does not direct one skilled in the art to choose all the elements of independent claim 1 from among the many elements disclosed therein.

Applicants' independent claim 1 recites that component (II) is free from binders (I.1). As such, this recitation is a required limitation of Applicants' claimed invention. There must be no difference between the claimed invention and the disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech Inc.*, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991).

Hellmann, on the other hand, does not teach or suggest this required element of the claimed invention. In fact, Hellmann teaches that according to a preferred embodiment, module B) contains binders in addition to the adhesion additive. For example, Hellman teaches that such binders preferably comprise at least one of the binders which are also used in the base module A). (Hellmann, paragraph [0048]).

In addition, Applicants' independent claim 1 further requires that component (I) be free from chlorinated polyolefins. Hellmann does not teach or suggest that that module A) is free from chlorinated polyolefins.

For at least the foregoing reasons, Hellmann does not teach or suggest all the elements of independent claim 1. Therefore, Hellmann cannot anticipate Applicants' independent claim 1. A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 31 U.S.P.Q.2d 1671 (Fed Cir. 1994).

Furthermore, Hellmann teaches four modules A) to D), neither of which being a component comprising at least one polyisocyanate in accordance with independent claim 1's component (III). Hellmann teaches that in addition to the modules A) to D) described above, the modular system according to the invention may additionally also contain at least one crosslinking agent module E). (Hellmann, paragraph [0058]). Therefore, Hellmann does not teach all of the claimed elements "arranged as in the claim" as is required by the courts.

In addition, Applicants' claim 1 requires at least one organic solvent in component (I). Hellmann teaches that organic solvents and/or water may be present in the base module as component A4). (Hellmann, paragraph [0040]). Therefore, Hellmann does not direct one with ordinary skill in the art to clearly and unequivocally select an organic solvent without any need for picking, choosing, and combining.

Further, pending claim 1 requires at least one organic solvent in component (II). Hellmann teaches that the adhesion module B) may also contain organic solvents and/or water together with further conventional coating additives and/or extenders. (Hellmann, paragraph [0047]). Therefore Hellmann does not direct one with ordinary skill in the art to choose organic solvents from among the several additives and solvents that can be added to B).

In addition, claim 1 requires (III) a component comprising at least one polyisocyanate (III.1). Not only does Hellmann not teach Applicants' component (III) "arranged as in the claim" as discussed above, but also Hellmann teaches that hydroxyl, isocyanate, acetoacetyl, olefinically unsaturated groups, epoxy, carboxyl, and amino groups, may be considered as crosslinking agents, in addition to polyepoxides, glycidyl-functional polymers, blocked polyamines, carboxy-functional polyesters, polyurethanes, and/or poly(meth)acrylates, and polyfunctional carboxylic acids. That is, Hellmann teaches isocyanates from among about fourteen possible crosslinking agents. Therefore, Hellmann again does not teach Applicants' polyisocyanates "arranged as in the claim", nor does Hellmann direct one with ordinary skill in the art to choose polyisocyanates without the need for picking, choosing, and combining.

In view of the above, Applicants respectfully assert that the present claims are not anticipated by Hellmann because Hellmann does not teach all the elements of the present claims, nor does Hellmann teach the elements of independent claim 1 “arranged as in the claim”, and Hellmann does not direct one with ordinary skill in the art to Applicants’ independent claim 1 without the need for picking, choosing and combining.

Withdrawal of this rejection is respectfully requested.

3. **Rejection of claims 19-20 under 35 U.S.C. §103(a) as being unpatentable over Hellmann, in view of U.S. Patent No. 6,939,916 to Merritt et al., hereafter “Merritt”.**

Merritt teaches an adhesion promoter composition that includes a chlorinated polyolefin and an olefin-based block copolymer that has an olefin block that is substantially saturated and at least one (poly)ester or (poly)ether block. The olefin-based block copolymer can be prepared by reacting an hydroxyl-functional, saturated or substantially saturated olefin polymer with a chain-extension reagent that is reactive with hydroxyl groups and will polymerize in a head-to-tail arrangement of monomer units. (Merritt, abstract).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

As discussed above, Hellmann does not teach or suggest all the elements of independent claim 1. This is not remedied by Merritt. Therefore, Applicants respectfully assert that claim 1 is patentable over the combination of Hellmann and Merritt. Consequently, so are claims 19-20, which depend from and further limit claim 1. Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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Friday, February 29, 2008

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